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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,101	01/20/2004	David R. Loveday	1999U026.RE.US	4294
25959	7590	08/11/2006	EXAMINER	
UNIVATION TECHNOLOGIES LLC			CHEUNG, WILLIAM K	
5555 SAN FELIPE, SUITE 1950			ART UNIT	
HOUSTON, TX 77056			PAPER NUMBER	
			1713	
DATE MAILED: 08/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,101

Applicant(s)

LOVEDAY ET AL.

Examiner

William K. Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1, 3-12, 15, 17-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on July 26, 2006 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/761,101 is acceptable and a RCE has been established. An action on the RCE follows.
2. In view of the cancellation of claims 22-28, the objection of claims 22-48 is withdrawn. Claims 1, 3-12, 15, 17-21 are pending.
3. In view of amendment filed July 26, 2006, the objection of the specification is withdrawn.

### **Non-Compliance**

4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. A new declaration is needed.

Applicants' oath/declaration filed July 26, 2006 has been fully considered, and the examiner finds it not persuasive because applicants fail to recognize that oath/declaration fails provide a reference with incorrect patent number.

5. Regarding the amendment on specification (col. 6, line 47 to col. 8, line 2; col. 8, line 14-44; col. 9, line 9-25; col. 9, line 62 to col. 10, line 25), the amendment to change "M" to "M'", the examiner cannot find the proper support for the change. As written in the original specification, the M cited in Formula I and II (col. 3, line 15-33) are identical to the M cited structure III (col. 6, line 49-50). There is not an indication that the M of Formula I and II and the M of structure III can be different. Therefore, the recitation "M'" is considered new matter because "M'" is not supported by the original specification.

6. Regarding claims 12, 15, the recitation "M'" is considered new matter because "M'" is not supported by the original specification. As written in the original specification, the M cited in Formula I and II (col. 3, line 15-33) are identical to the M cited structure III (col. 6, line 49-50). There is not an indication that the M of Formula I and II and the M of structure III can be different.

Applicants must also recognize that the recitation "M'" throughout the instant application is not supported by the original application, and is therefore considered "new matter" which must be removed by an amendment submitted by applicants.

7. Claims 1, 3-12, 15, 17-21 are objected In view of the non-compliance issues set forth above.

8. Under 37 CFR 1.176 permits the examiner to make a requirement for restriction. Where a restriction requirement is made, the original patent claims will be held to be constructively elected. (See MPEP 1450) The invention of claims 1, 3-12, 15, 17-21 are considered patentably distinct from the patented claims 1-21 and is considered a non-elected subject matter of patented invention of claims 1-21. The invention of instant claims 1, 3-12, 15, 17-21 is drawn to the preparation of emulsion or a suspension, classified as 524/800 while the patented claims 1-21 are drawn to an invention classified in 526/161.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Applicant's arguments filed July 26, 2006 have been fully considered but they are not persuasive. Applicants argue that it is unclear how the patented claims be restricted with the pending claims. Applicants must recognize that the instant restriction is set forth because applicants' pending claims are not drawn to the class and subclass of the patented claims as cited on US 6,274,684. To overcome the restriction set forth, applicants should amend the claims without changing their class and subclass, or file a divisional application with the restricted claims. Applicants must recognize that reissue application is to correct scope of the claimed invention without altering its type of invention.

Applicants must also recognize that the recitation "a dispersion" of claim 1 (line 10) is not supported by the original application of US 6,274,684, and is therefore considered "new matter" which must be removed by an amendment submitted by applicants.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Patent Examiner

August 4, 2006

**WILLIAM K. CHEUNG  
PRIMARY EXAMINER**